



## UNITED STATES DEPARTMENT OF COMMERCE

## Patent and Trademark Office

Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231

J

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/091,602	04/19/99	BUNGER	J BEIERSDORF50

HM22/0926  
SPRUNG KRAMER SCHAEFER & BRISCOE  
660 WHITE PLAINS ROAD  
TARRYTOWN NY 10591-5144

EXAMINER	
TRAVERS, R	

ART UNIT	PAPER NUMBER
1617	10

DATE MAILED:  
09/26/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

<b>Office Action Summary</b>	Application No. <b>09/091,602</b>	Applicant(s) <b>Benger et al</b>
	Examiner <b>RUSSELL TRAVERS</b>	Group Art Unit <b>1617</b>

Responsive to communication(s) filed on Jul 5, 2000

This action is **FINAL**.

Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

#### Disposition of Claims

Claim(s) 2-9 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

Claim(s) \_\_\_\_\_ is/are allowed.

Claim(s) 2-9 is/are rejected.

Claim(s) \_\_\_\_\_ is/are objected to.

Claims \_\_\_\_\_ are subject to restriction or election requirement.

#### Application Papers

See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

The proposed drawing correction, filed on \_\_\_\_\_ is  approved  disapproved.

The specification is objected to by the Examiner.

The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. § 119

Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

All  Some\*  None of the CERTIFIED copies of the priority documents have been

received.

received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

#### Attachment(s)

Notice of References Cited, PTO-892

Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

Interview Summary, PTO-413

Notice of Draftsperson's Patent Drawing Review, PTO-948

Notice of Informal Patent Application, PTO-152

-- SEE OFFICE ACTION ON THE FOLLOWING PAGES --

Art Unit:

The amendment filed July 5, 2000 has been received and entered into the file.

Applicant's arguments filed July 5, 2000 have been fully considered but they are not deemed to be persuasive.

Claims 2-9 are presented for examination.

Applicant's election with traverse of a specific bacteria in Paper No. 9 is acknowledged. The traversal is on the ground(s) that Applicants must the prosecution before a proper election can be made. This is not found persuasive because an election is required to proceed with examination on the merits. Additionally, once an action on the merits has been entered, inventive subject matter under examination is fixed.

The requirement is still deemed proper and is therefore made FINAL.

The following is a quotation of the first paragraph of 35 U.S.C. § 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The specification is objected to under 35 U.S.C. § 112, first paragraph, as failing to adequately teach how to make and/or use the invention, and thereby failing to provide an enabling disclosure.

Art Unit:

The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 2, 4, 5 , 6, 7, and 8 are rejected under 35 U.S.C. § 102(b) as being anticipated by Matsumura et al, or Shoji et al, or Ikekawa et al.

The following is a quotation of 35 U.S.C. § 103 which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Subject matter developed by another person, which qualifies as prior art only under subsection (f) or (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

Claims 2-9 are rejected under 35 U.S.C. § 103 as being unpatentable over Matsumura et al, Shoji et al, and Ikekawa et al, in view of Ziolkowsky.

Art Unit:

Matsumura et al, Shoji et al, and Ikekawa et al teach the claimed compounds as old and well known in combination with various pharmaceutical carriers and excipients in a dosage form. This medicament is taught as useful for treating various etiological agents, to include those recited herein. Claims 3 and 9, and the primary references, differ as to:

- 1) the employment of these medicaments dermally or cosmetically, and
- 2) administration levels of the medicaments.

Ziolkowsky teaches the claimed compounds as useful for a dermal, cosmetic use. Possessing this teaching, the skilled artisan would have been motivated to employ the claimed compounds for the dermal, or cosmetic use herein claimed and enjoy a reasonable expectations of therapeutic success.

Determining the active ingredient dosage level required to effect optimal therapeutic benefit is well within the Skilled Artisan's purview and the benefits of achieving such maximization obvious, to said skilled artisan. The claims merely recite the obvious employment of old and well known active ingredients, carriers and excipients. Thus, the only issue presented in the instant application is the obviousness of the claimed therapeutic methods.

Art Unit:

Claim 9 specifically requires dermal pharmaceutical composition or cosmetic composition. Ziolkowsky employed the claimed compound in an dermal and cosmetic form, not specifically reciting another formulation. The skilled artisan would have seen dermal pharmaceutical composition or cosmetic compositions, and the administration of these compounds by these conventional means as residing in the skilled artisan purview.

No claims are allowed.

Any inquiry concerning this communication should be directed to Russell Travers at telephone number (703) 308-4603.



**Russell Travers  
Primary Examiner  
Art Unit 1617**